



PTO/SB/21 (07-06)

Approved for use through 09/30/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**TRANSMITTAL
FORM**

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

31

Application Number

10/004,823

Filing Date

December 7, 2001

First Named Inventor

John R. Moody

Art Unit

3653

Examiner Name

M.E. Butler

Attorney Docket Number

2324 (GP-00-41)

ENCLOSURES (Check all that apply)☐

Fee Transmittal Form

☐

Fee Attached

☐

Amendment/Reply

☐

After Final

☐

Affidavits/declaration(s)

☐

Extension of Time Request

☐

Express Abandonment Request

☐

Information Disclosure Statement

☐

Certified Copy of Priority Document(s)

☐Reply to Missing Parts/
Incomplete Application☐Reply to Missing Parts
under 37 CFR 1.52 or 1.53☐

Drawing(s)

☐

Licensing-related Papers

☐

Petition

☐Petition to Convert to a
Provisional Application☐

Power of Attorney, Revocation

☐

Change of Correspondence Address

☐

Terminal Disclaimer

☐

Request for Refund

☐

CD, Number of CD(s) _____

☐

Landscape Table on CD

☐

After Allowance Communication to TC

☐Appeal Communication to Board
of Appeals and Interferences☒Appeal Communication to TC
(Appeal Notice, Brief, Reply Brief)☐

Proprietary Information

☐

Status Letter

☒Other Enclosure(s) (please identify
below):

Return Postcard

Remarks

2nd Substitute Brief on Appeal

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name

Ferrells, PLLC

Signature

Printed name

Michael W. Ferrell; CUSTOMER NO. 40256

Date

August 30, 2006

Reg. No.

31,158

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature

Typed or printed name

Linda Kenah

Date

August 30, 2006

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

John. R. Moody

U.S. Serial No. 10/004,823

Filed December 7, 2001

Docket No. 2324 (GP-00-41)

For: Modified Gravity-Feed Multi-Fold Towel
Dispenser

:

:

:

:

:

:

:

Examiner: M. E. Butler

Group Art Unit: 3653

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

SECOND SUBSTITUTE BRIEF ON APPEAL
UNDER 37 CFR §41.37(c)

Sir:

Applicant hereby submits this *Second Substitute Brief on Appeal* with a corrected summary of the claimed subject matter as directed by the *Order* in this case mailed July 5, 2006, as well as a corrected Appendix VIII and Section III responsive to the Office Action of August 15, 2006. A reference table (page 5) mapping the independent claims on appeal to the specification and drawings has been added to Section V.

If any additional fees are due or an *Extension of Time* is required, please consider this paper a petition therefor and charge fees related to this *Brief* to our Deposit Account No. 50-0935.

I. REAL PARTY IN INTEREST

The real party in interest in this case is Georgia-Pacific Corporation, Assignee of Record.

The Assignment recordation is dated December 7, 2001, Reel 012357/Frame 0704.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals, interferences or judicial proceedings related to, or which will affect, or which will be affected by, or which will have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

Claims 1-10, 21 and 22 stand finally rejected in this application and are on appeal. Claims 11-20 have been cancelled. A complete listing of claims on appeal is provided in Appendix VIII.

IV. STATUS OF AMENDMENTS

No amendments have been filed subsequent to the *Final Rejection* of July 28, 2005.

V. SUMMARY OF CLAIMED SUBJECT MATTER

In accordance with the invention, an adapter plate is secured to the bottom portion of the dispenser and operates to abridge the length of the dispensing aperture to between about 80 and about 90 percent of the transverse length towel in the dispenser. The adapter operates to promote dispensing of towels, while virtually eliminating multiple towel dispensing or "fall through." Claim 1 is representative of the subject matter on appeal:

A modified gravity-feed towel dispenser for dispensing C-fold and interfolded towels, wherein said dispenser houses C-fold or interfolded towels having a transverse length, L, which are positioned to be dispensed through an elongated bottom dispensing aperture having a length of L or greater, said towel dispenser including means for defining a top portion, a front wall, a back wall and a pair of side walls of said towel dispenser, as well as a bottom portion collectively defining an interior for receiving a stack of C-fold or interfolded towels, said bottom portion of said towel dispenser defining said elongated bottom dispensing aperture, wherein an adapter plate is

secured to said bottom portion of said towel dispenser and is configured to abridge the length of said dispensing aperture to a length L' of from about 80 percent to about 90 percent of said transverse length, L , of said C-fold or interfolded towels.

The subject matter of independent Claim 1 is illustrated in **Figures 1 and 2-6** of the application as filed, and is described at page 6, line 13 through page 8, line 6. That disclosure is summarized briefly below.

The invention is practiced by abridging the dispensing slot of a dispenser as can be seen from **Figure 2**:

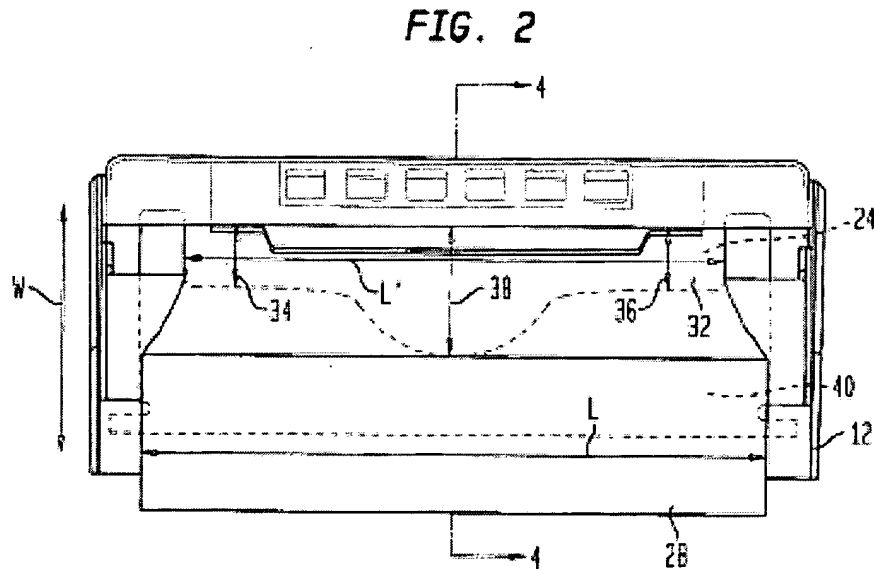


Figure 2 is a bottom view of a towel dispenser configured with an adapter plate in accordance with the present invention. The towel dispenser defines an elongate bottom dispensing aperture 24 through which a towel 28 passes upon dispensing. The towel 28 has a transverse length, L , and the dispensing aperture has a length of L or greater. The claimed invention operates to abridge the length of the dispensing aperture to a length, L' , of from about 80 to 90 % of the transverse length, L , of the towel. A preferred embodiment of the adapter plate, which is encompassed by Claims 2 through 6, can be further illustrated by **Figures 5 and 6**:

FIG. 5

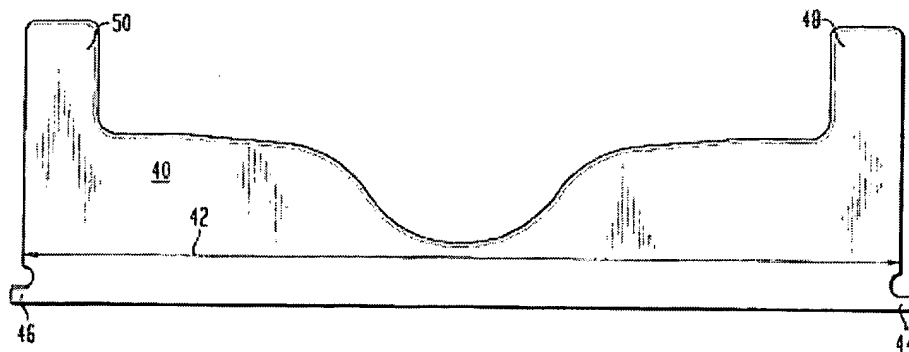


FIG. 6

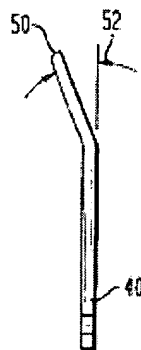


Plate **40** is an elongate member with a generally planar mid portion and further has two terminal portions **48, 50** (See **Figure 2, previous page**) projecting outwardly and upwardly with respect to the planar portion at an angle of inclination **52**. The terminal portions operate to abridge the length of the dispensing aperture when the plate is mounted in the bottom portion of the dispenser. A reference table mapping the independent claims on appeal and the dependent claims argued separately to the specification and drawings appears below.

Reference Table For Independent Claims on Appeal and Dependent Claims on Appeal Argued Separately

<p>Claim 1 recites a modified towel dispenser for folded towels having a transverse length L provided with an aperture of a length L or greater and an adapter plate abridging the aperture to a length L' which is from about 80% to 90% of length L.</p>	<p>The subject matter of Claim 1 is described in the application as filed and illustrated in Figures 1,2 and 4. Figure 1 shows a dispenser 10 with an aperture 24 of length L. Text describing these features is at page 4, line 10 to page 5, line 26. Aperture 24 is abridged by adapter plate 40 to L'. See Figure 2, as well as text at page 6, line 13 continuing on page 7.</p>
<p>Claim 21 claims a towel dispenser with an adapter plate including generally the features of Claim 1. Additionally, the adapter plate is recited to be pivotally mounted.</p>	<p>The subject matter of Claim 21 is described in the application as filed and illustrated in Figures 1,2 and 4. Figure 1 shows a dispenser 10 with an aperture 24 of length L. Text describing these features is at page 4, line 10 to page 5, line 26. Aperture 24 is abridged by adapter plate 40 to L'. See Figure 2, as well as text at page 6, line 13 continuing on page 7. The pivotal mounting of the adapter plate is described on page 6 of the application as filed, lines 13+, where it is stated plate 40 is mounted with projections 44, 46. See Figure 1 also.</p>
<p>Claim 2 recites that the adapter plate has a generally planar medial portion and upwardly inclined terminal portions.</p>	<p>Adapter plate 40 is illustrated in Figures 5, 6 including laterally projecting terminal portions 48, 50 having an angle of inclination 52. See associated text at page 6, line 13 continuing on page 7 of the application as filed.</p>

The inventive modified dispenser has markedly superior dispensing properties over the dispensers of the prior art because dispensing problems of the prior art are virtually eliminated. For example, a common prior art problem occurs where more than one towel comes out of the dispenser in a dispensing attempt. Another common problem of prior art dispensers is where a clump of towels fall out of the dispenser during a dispensing attempt. In both instances, paper is wasted. The present invention achieves a remarkably low rate of dispensing problems as is evidenced by Examples 446-2160 of the pending application. For example, when a dispenser was fitted with the inventive adapter plate with towels in the “tail backward” configuration, there were no occurrences of more than one towel coming out of the dispenser out of 610 attempts. There were also no occurrences of any towels falling out through the dispensing aperture. In contrast, when the dispenser was tested without the adapter plate, more than one towel came out at a rate of 1.85% and towels fell out of the dispenser at a rate of 15.74%. And, when a dispenser fitted with a prior art adapter (as shown in **Figure 3** of the pending application) was tested, more than one towel was dispensed at a rate of 1.35 % and towels fell out at a rate of 11.91%. Thus, the claimed invention achieves superior results. These results are enumerated in the application as filed, pages 9-10.

For purposes of this *Appeal*, the pending claims are divided into Groups as follows:

Group I includes Claims 1, 7-10, 21 and 22; and

Group II includes Claims 2 through 6.

ADDITIONAL EVIDENCE SUBMITTED BEARING UPON PATENTABILITY

Attached in Appendix IX is additional evidence bearing upon patentability. In particular, there is provided an *Affidavit of Michael E. Butler* (Examiner in this case) which states that the commercial dispenser relied upon in making the rejections of item G, section VI, below, has a dispensing slot length of 10-1/2 inches and a dispensing magazine having a corresponding length of 11 inches. This geometry indicates a minimum relative dispensing aperture length of 95% of the towel transverse length dispensed by the device, well outside the range claimed in this case. This affidavit also contradicts the *Final Rejection* which states the dispensing slot of the commercial

dispenser is 9.75 inches long, rebutting any suggestion whatsoever of the claimed subject matter. Also included in Appendix IX are selected photographs which appear to show that the aperture in fact extends the entire distance between the magazine sidewalls of the commercial dispenser, consistent with a patent filed by the manufacturer; again contradicting the rejections made.

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

In the *Final Rejection* of July 28, 2005, the following eight (8) rejections were made:

- A. Claims 3, 5 and 10 were objected to as to use of the term “about”;
- B. All claims were rejected under 35 USC §112, ¶1 as to claiming relative length of the aperture as compared with the towel being dispensed;
- C. All claims were objected to under 35 USC §112, ¶2 as to use of the term “about” and use of the term “or”;
- D. All claims were rejected under 35 USC §102 as anticipated by United States Patent No. 6,003,723 to *Morand*;
- E. Claims 1-5 and 7-10 were rejected under 35 USC §103(a) as obvious over United States Patent No. 5,950,863 to *Schutz et al.*;
- F. Claims 1-5 and 7-10 were rejected under 35 USC §103 as obvious over *Schutz et al.* in view of *Morand*;
- G. Claims 1-8 and 21-22 were rejected under 35 USC §103 as obvious over United States Patent No. 5,957,324 to *Gettelman et al.* in view of a commercial dispenser; and

H. Claims 1-10 and 21-22 were rejected under 35 USC §103 as obvious over United States Patent No. 5,322,186 to *Frazier et al.* in view of *Morand*.

Applicant appeals herewith from each ground of rejection.

VII. ARGUMENT

All rejections made in this case should be reversed. The art does not disclose, teach or suggest the claimed subject matter and the §112 rejections are untenable.

re rejections ABC: The §112 rejections are contrary to well established norms and should be reversed

Turning to the §112, first paragraph rejections, the claims positively recite a dispenser which contains towels of specified length relative to the abridged aperture. The Examiner's comments notwithstanding, the towel is thus not of an arbitrarily selected length and there is no need for adjustable structure other than that which is illustrated and claimed. That is, the amount of dispensing aperture length abridgement that is accomplished by the adapter plate relative to the towel is claimed. As such, all claims are believed to most clearly comply with the written description requirement.

Regarding the §112, second paragraph rejections, the Examiner rejected the claims as indefinite for the following reasons: (1) the term "about" is indefinite because no tolerances are listed; (2) the claims premise the dimensions of the slot upon a variable-width of the towel; (3) the term "or" is unclear as to whether it is claiming alternate embodiments or a device capable of reconfiguration; and (4) that it is ambiguous as to whether the claims encompass a stand alone adapter plate or an adapter plate while in a dispenser. Such comments are likewise contrary to established norms. The term "about" is widely used and is sufficiently definite to apprise one of skill in the art what the applicant regards as its invention. Generally, the phrase "about" is considered to be "clear but flexible and is deemed to be similar in meaning to terms such as 'approximately' or 'nearly.'" *Ex parte Eastwood, Brindle, and Kolb*, 163 USPQ 316, 317 (B.P.A.I.

1969); *See also*, *BJ Services Co. v. Halliburton Energy Services Inc.*, 67 USPQ2d 1692, 1694 (Fed. Cir. 2003); *W.L. Gore & Associates, Inc. v. Garlock*, 220 USPQ 303 (Fed. Cir. 1983). Applicant further notes on this point that two of the cited references contain similar claim language. (*Morand* at Claim 1, item (b); *Schutz* at claim 4). *See also* MPEP § 2173.05 (b) wherein it is noted when there is very close prior art and it is not possible to characterize the differences between the prior art and the claimed subject matter due to the use of the term “about” that the term is objectionable. Here, neither aspect of the exceptional circumstances where “about” language is objectionable is remotely applicable. The art is not close. The art does not show any adapter plate abridging the length of a dispensing aperture to any significant degree at all; the Examiner’s comments notwithstanding. Moreover, the differences between any relevant art and the claimed subject matter is readily determined by linear measurement, using a ruler, for example, should the need arise. For sure, “about” in a claim does not make the other recitation disappear.

Nor do the pending claims premise the dimensions of the aperture upon an extrinsic unclaimed variable because the amended claims recite a dispenser housing towels with traverse length, L . The abridged aperture has a definite length, L' , relative to the length of the towels. Claims are interpreted to have their ordinary meaning, not some unusual and arbitrary construction unrelated to the specification and drawings.

Regarding the Examiners rejection due to alternate “or” language, many gravity-feed towel dispensers which are capable of dispensing C-fold towels are also capable of dispensing interfolded towels, and vice-versa. The use of the word “or” in the claim merely reflects the fact that the dispenser typically only houses and dispenses one or the other type of towel at a given time. There is no basis whatsoever to require different language; an applicant is entitled to claim an invention in any appropriate manner.

As to Claims 3, 5, and 10, Applicant submits that all of the dependent claims are in proper form because they further limit the base claim. Tolerances for the ranges are unnecessary because a person of ordinary skill in the art would readily recognize that dependent claims having smaller ranges than a base claim further limits the base claim; the Examiner’s comments notwithstanding.

For example, Claim 3 recites a range for the length of “about 85 percent.” Claim 3 depends from Claims 2 and 1 which recites a range of “about 80 to about 90 percent.”

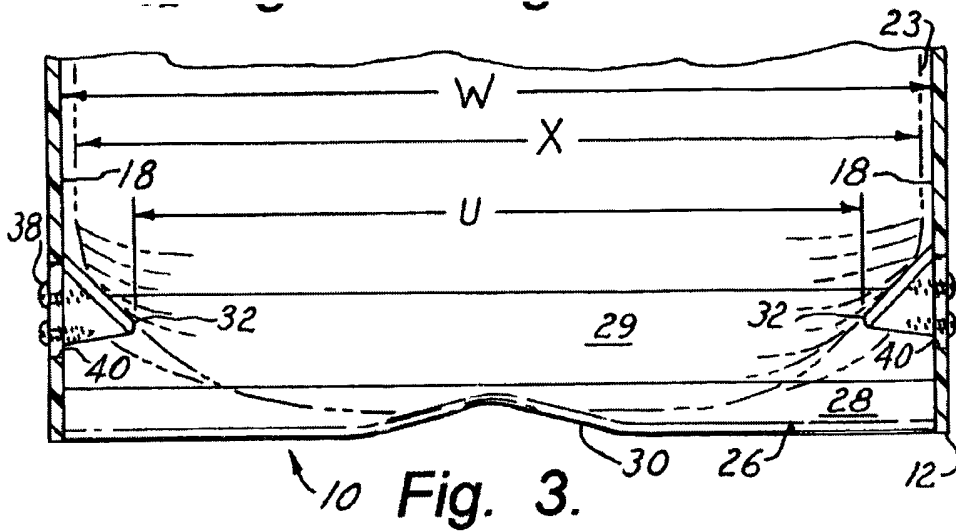
Accordingly, all of the § 112 rejections should be reversed.

re rejection D: The claimed subject matter is not remotely suggested by United States Patent No. 6,003,723 to *Morand*;

The Examiner is apparently under the mistaken belief that *Morand* teaches to abridge a dispensing aperture, relying, in part, on Col. 4, lines 13-20 of that reference:

According to the present invention, a pair of sloping shelf members **32** are mounted on inside surfaces of the side walls
 15 **18**, approximately centered between the back and front walls **16** and **22** for partially supporting the stack **23**. More particularly, the shelf members **32** are spaced laterally apart by a distance U, at a distance B above the lip extremities **26** of the funnel portion **20**, the distance U being not greater
 20 than approximately 90 percent of the stack width X. In an

That disclosure relates to **Figure 3** of *Morand*, which shows that the distance U is **nowhere near the dispensing slot of the dispenser:**



The shelves **32** in *Morand* do not abridge the length of the dispensing aperture. The shelves are placed at a vertical distance above the dispensing aperture such that the towels are still dispensed directly through the feed slot. The shelves simply separate the towels more so that there are fewer towels wholly supported by the bottom feed slot at any given time and the dispenser does not jam (a problem known in the art and unrelated to the drawbacks cured by the invention of this application).

dispensing slot **24** extends the entire length of the body of the dispenser which is longer than the towel length. Thus, the aperture could not have a length of from about 80 to about 90 percent of the length of the sheet, as recited in Claims 1 and 21. *See also* col. 3, lines 58-59 of *Morand*. Indeed, the aperture disclosed by *Morand* is designed to be larger than the towel length. The prototype disclosed in *Morand* has a length of 9.75 inches and holds towels which have a transverse length of 9.59 inches. Again, this is well outside of the range recited in Claims 1 and 21.

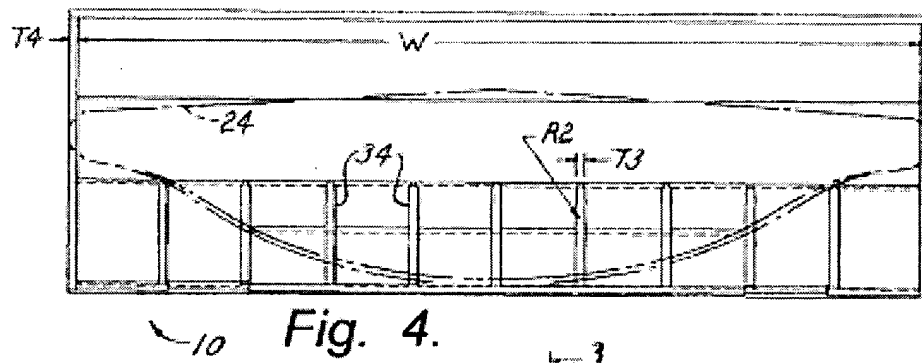
Morand has nothing to do with preventing “fallout” and accompanying paper waste and fails to even remotely suggest the claimed structure in this case, even more so with respect to Claim Group II, discussed below.

re: Claim Group II and *Morand*

Morand does not disclose or suggest the elements of Claim 2, reciting that the adapter plate is an elongate member with a planar medial portion with a pair of upwardly inclined terminal portions at each end. On this point, the Examiner cited item **20**, the funnel portion in **Figures 1 and 7** as disclosing an adapter plate. There is no adapter plate in the reference. Item **20**, described in *Morand* as the funnel portion, is comprised of funnel walls (**20A** and **20B**), and side walls (**18**). Neither the funnel portion or its individual components have a plate which is an elongate member having a planar middle portion and a pair of upwardly and outwardly projecting end portions. Similarly, the angles of inclination as recited in Claims 4 and 5 are not disclosed by *Morand*. The portion of the specification cited by the Examiner gives the side angle of the shelf members to be approximately 45°, also corresponding to an angle of inclination of 45°. Aside from the fact that the shelf members are not terminal portions of an adapter plate, the angle of 45° is well outside the range recited by Claim 4 (10 to 30 degrees), and is not near the angle recited by Claim 5 (20 degrees). Furthermore, *Morand* does not disclose that the plate be pivotally secured to the towel dispenser as recited in Claims 6. The reference is entirely different than the claimed subject matter.

re rejection E: Claims 1-5 and 7-10 are Patentable over United States Patent No. 5,950,863 to Schutz et al.

The dispenser insert disclosed in *Schutz et al* does not suggest any means operative to abridge the length of a dispenser slot such that the abridged length is from about 80-90% of the transverse length of the towels; the Examiner's comments notwithstanding. **Figure 4** of *Schutz et al.*, reproduced below, is a top view of the adapter insert positioned within a dispenser.



It is clear from the *Schutz et al.* disclosure, in particular **Figures 1, 4, and 10**, that the *Schutz* insert operates to restrict the width of a dispensing aperture, not its length. Moreover, there is no disclosure in *Schutz* that states how much the aperture is abridged along the width, if at all. Notice here, that in the experimental tests disclosed in *Schutz*, the length of the dispensing aperture after the insert was placed in the dispenser was 10.3 inches. (col. 5, lines 27-31). The paper used in the tests was only 9.38 inches long. (col. 6, lines 1-6). This means that the *Schutz et al.* reference specifically discloses an aperture that is approximately 110% of the transverse length of the towel. And, in a preferred embodiment of *Schutz et al.*, the dispensing aperture was 9.721 inches when the insert was placed in a dispenser. (col. 8, lines 13-15). Thus, in the preferred embodiment of *Schutz*, the aperture would have a length that is approximately 103.5 % of the length of the dispensed towel. Both values are clearly outside the claimed range.

re: Claim Group II and *Schutz et al.*

Further features claimed in the pending application are also never disclosed or suggested by *Schutz et al.* For example, Claim 2 recites that the adapter plate is an elongate member having a pair of *terminal* portions that extend upwardly and outwardly with respect to the planar medial portion *at the end* of the adapter plate. The *Schutz et al.* disclosure does not disclose structure that is even remotely similar to the structure recited in Claim 2. The Examiner mistakenly asserts that the funnel member in *Schutz et al.* (item 48) discloses the structure of the adapter plate. As stated in the disclosure, the funnel member of *Schutz et al.* includes the rib portion (14), the side portions (16), the ledge portion (18) and a rear portion (54). The combination of these four surfaces is a box-like structure that does not suggest an adapter plate. Also, even the individual components of the funnel member do not have structure where a pair of terminal portions on the end of the plate extend upwardly and outwardly from a planar medial portion. The elements of claim 4 are similarly not disclosed which recite that the terminal portions have an angle of inclination of about 10 to about 30 degrees. On this point, the Examiner appears to note that the angle θ in *Schutz et al.* discloses the elements of Claim 4. The angle θ discloses the angle at which the rib portion (14) inclines. Here again it is clear from **Figs. 1-3** that the rib portion of *Schutz et al.* does not resemble the claimed structure, *i.e.*, a pair of terminal portions which extend from each end of a medial portion of an adapter plate.

re rejection F: Claims 1-5 and 7-10 are patentable over *Schutz et al.* in view of *Morand*

The proposed combination of *Schutz et al.* in view of *Morand* has not been justified in any substantial manner and is thus contrary to the Federal Circuit's holding in *In re Lee*. In particular, the motivation to combine in the manner urged by the Examiner must appear in the references:

In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.”); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination “only by showing some objective teaching in the prior art or that

knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references”).

With respect to Lee's application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The examiner's conclusory statements that “the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software” and that “another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial” do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to “[use] that which the inventor taught against its teacher.” *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.

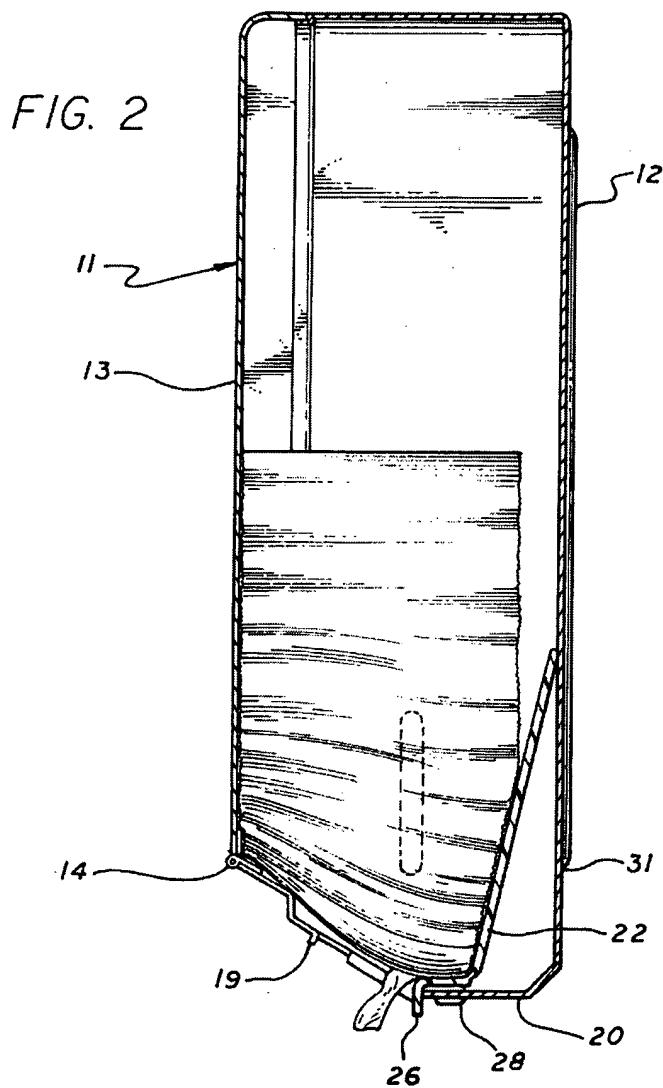
Deferential judicial review under the Administrative Procedure Act does not relieve the agency of its obligation to develop an evidentiary basis for its findings. To the contrary, the Administrative Procedure Act reinforces this obligation. See, e.g., *Motor Vehicle Manufacturers Ass'n v. State Farm Mutual Automobile Ins. Co.*, 463 U.S. 29, 43 (1983) (“the agency must examine the relevant data and articulate a satisfactory explanation for its action including a rational connection between the facts found and the choice made.”) (quoting *Burlington Truck Lines v. United States*, 371 U.S. 156, 168 (1962)); *Securities & Exchange Comm'n v. Chenery Corp.*, 318 U.S. 80, 94 (1943) (“The orderly function of the process of review requires that the grounds upon which the administrative agency acted are clearly disclosed and adequately sustained.”).

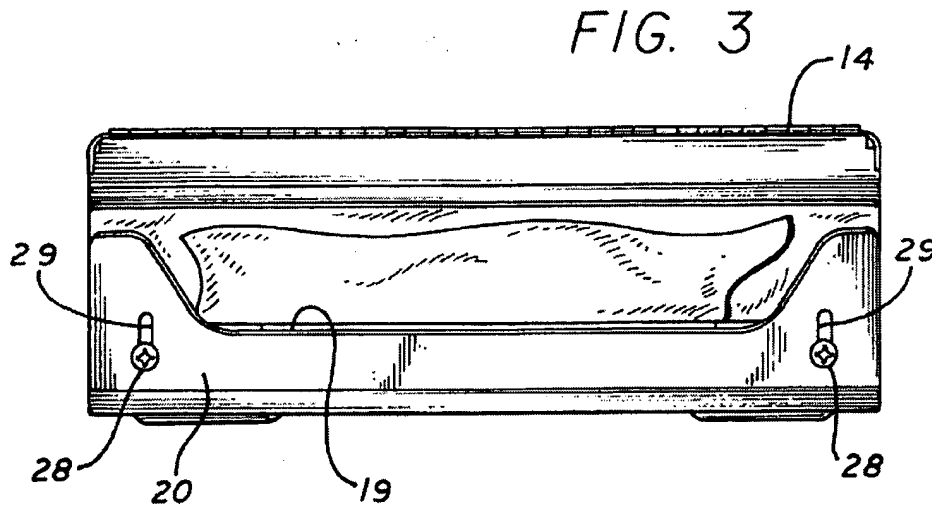
In re Lee, 61 USPQ2d 1430, 1434 (CAFC 2002).

Even if the combination were proper, the references do not disclose (a) the relative aperture/towel lengths claimed nor (b) the adapter plate which is claimed. Accordingly, all claims are allowable over *Schutz et al.* in view of *Morand* in any event.

re rejection G: Claims 1-8 and 21-22 were rejected under 35 USC §103 as obvious over United States Patent No. 5,957,324 to Gettelman et al. in view of a commercial dispenser

Similar to the *Schutz et al.* reference, the adapter disclosed by *Gettelman et al.* abridges the width of the storage cavity, not the length of the dispensing slot as recited by Claims 1 and 21. This can be seen by **Figures 2, 3** of *Gettelman et al.*, where the adapter **22** is an elongated piece and runs lengthwise with respect to the aperture:





Furthermore, the notion that the commercial PTO dispenser provides motivation to modify the adapter plate of *Gettelman et al.* is hindsight. An adapter plate modifies a dispenser, not vice-versa. Accordingly, the rejection does not meet the criteria of *In re Lee*.

Note also, the dispensing aperture extends the entire distance between sidewalls, consistent with the photographs submitted by the Examiner.

The commercial dispenser was asserted in the *Final Rejection* to have a 9.75 inch dispensing slot between 11 inch sidewalls (88%). See *Final Rejection*, p. 9, center of page. That statement is clearly mistaken. The Examiner's *Affidavit*, Appendix IX, contradicts that assertion stating that the dispensing slot is 10-1/2 inches or over 95% of the distance between sidewalls; not at all suggestive of the claimed relative length of about 80-90%.

Furthermore, upon examination of the Appendix IX photographs of the dispenser furnished with the *Final Rejection*, it appears that the dispensing slot actually extends from sidewall to sidewall, just as in **Figure 3** of *Gettelman et al.* '534 seen above, and therefore does not at all suggest dispensing a towel through an aperture shorter than the towel. *Note* that the manufacturer of

the commercial dispenser and the Assignee of *Gettelman et al.* '324 are the same – Bobrick Washroom Equipment, Inc.

The additional evidence overwhelmingly refutes the rejection based on *Gettelman et al.* '324 and the Bobrick dispenser.

re rejection H: Claims 1-10 and 21-22 are patentable over United States Patent No. 5,322,186 to *Frazier et al.* in view of *Morand*

The Examiner also rejected all pending claims under §103 as being unpatentable over *Frazier et al.* in view of *Morand*.

This rejection is also improper in that no motivation is shown to modify *Frazier et al.* in the manner asserted. Accordingly, the rejection does not meet the *In re Lee* criteria.

In this rejection, the Examiner stated: “It would have been obvious for Frazier to have a dispensing aperture of about 80 to 90 percent of the towel length and preferably 85% to minimize fallout and double dispensing as taught by *Morand* and come up with the instant invention.” *Frazier et al.* relates to an insert for adapting an existing dispenser for a different size towel and has no suggestion whatsoever as to using a dispensing slot shorter than the transverse length of the towel being dispensed. Moreover, *Morand*, as stated above, does not disclose, teach or suggest abridging the length of the dispensing aperture to about 80 or 90 percent of the towel length, and the disclosure does not relate to reducing “fallout”. Instead, *Morand* teaches that the dispensing chute extends from sidewall to sidewall, a distance of 9.75 inches, and the towels used are 9.59 inches long. Thus, the chute is approximately 101.5% longer than the dispensed towel; the Examiner’s comments notwithstanding.

FURTHER REASONS FOR ALLOWANCE

None of the above references disclose or teach an adapter plate that is secured so that the length of the aperture is abridged from about 80 to about 90 percent of the towel transverse length.

The structure of a preferred adapter plate (as recited in Claim Group II) is similarly not disclosed or suggested. The adapter plate of the claimed invention is of remarkably simple construction in comparison to the cited art devices. This, however, does not render the invention obvious or otherwise unpatentable – indeed it may indicate significant advances over the complexity of prior art devices. *Sensonics Inc. v. Aerosonic Corp.*, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996); *See also, In re Oetiker*, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992). All claims are, therefore, believed in condition for allowance.

Even if the references, *prima facie*, suggested the claimed subject matter, the remarkable results achieved would in any event render the claimed subject matter patentable. In this respect, note the data in the application as filed, on pages 8-9, summarized below:

Configuration: Example Nos.	% occurrence dispensing more than one towel	% occurrence towels falling out	Numbers of towels on floor
Prior Art: Examples 1-445 and 1055-1599	0.9	7	163
Present Invention: Examples 446- 1055 and Examples 1600- 2160 combined	0	0.001	1

The adapter plate of the invention is nearly 100% effective in preventing towels from unintentionally falling out of the dispenser. This result is achieved by abridging the length of the dispensing aperture to 80-90 percent of the transverse length of the towels to be dispensed, as is claimed.

New and useful results such as seen with the invention are patentable. *In re Wright*, 122 USPQ 522, 524 (C.C.P.A. 1959) is *apropos*:

Though the court may have believed that each of the elements in the patented device was old, it does not follow that the combination was

unpatentable. We need not elaborate upon the rule that a novel combination of old elements which so cooperate with each other so as to produce a new and useful result or a substantial increase in efficiency, is patentable. See *Lewyt Corp. v. Health-Mor, Inc.*, 7 Cir., 181 F.2d 855, 85 USPQ 335 , certiorari denied 340 U.S. 823, 71 S.Ct. 57, 95 L.Ed. 605, 87 USPQ 432 ; *Blaw-Knox Co. v. Lain Co.*, 7 Cir., 230 F.2d 373, 108 USPQ 356 . *Weller Manufacturing Company v. Wen Products, Inc.*, 7 Cir., 231 F.2d 795, 798, 109 USPQ 73, 75 (1956).

CONCLUSION

For the above reasons, all outstanding rejections should be reversed and all claims should be allowed.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Mw Ferrell".

Michael W. Ferrell
Reg. No. 31,158

Ferrells, PLLC
4400 Fair Lakes Court, Suite 201
Fairfax, VA 22033-3899
Telephone: (703) 968-8600
Facsimile: (703) 968-5500
August 30, 2006



VIII. CLAIMS APPENDIX

CLAIMS ON APPEAL

1. (Rejected) A modified gravity-feed towel dispenser for dispensing C-fold and interfolded towels, wherein said dispenser houses C-fold or interfolded towels having a transverse length, L , which are positioned to be dispensed through an elongated bottom dispensing aperture having a length of L or greater, said towel dispenser including means for defining a top portion, a front wall, a back wall and a pair of side walls of said towel dispenser, as well as a bottom portion collectively defining an interior for receiving a stack of C-fold or interfolded towels, said bottom portion of said towel dispenser defining said elongated bottom dispensing aperture, wherein an adapter plate is secured to said bottom portion of said towel dispenser and is configured to abridge the length of said dispensing aperture to a length L' of from about 80 percent to about 90 percent of said transverse length, L , of said C-fold or interfolded towels.
2. (Rejected) The towel dispenser according to Claim 1, wherein the adapter plate is an elongate member with a generally planar medial portion and further comprises a pair of terminal portions projecting outwardly and upwardly with respect to the planar medial portion at each end of said adapter plate, such that the terminal portions are upwardly inclined with respect to the medial portion of the plate.
3. (Rejected) The towel dispenser according to Claim 2, wherein said elongated dispensing aperture is abridged to a length, L' , of about 85 percent of the transverse length L of said C-fold or interfolded towels.
4. (Rejected) The towel dispenser according to Claim 2, wherein the upwardly inclined terminal portions have an angle of inclination of from about 10 to about 30 degrees with respect to the generally planar medial portion of the adapter plate.

5. (Rejected) The towel dispenser according to Claim 4, wherein the upwardly inclined terminal portions have an angle of inclination of about 20 degrees with respect to the generally planar medial portion of the adapter plate.
6. (Rejected) The towel dispenser according to Claim 2, pivotally secured to the lower portion of said gravity-feed towel dispenser.
7. (Rejected) The towel dispenser according to Claim 1, wherein said adapter plate is configured to define a central enlarged portion of the dispensing aperture and two restricted terminal portions of the dispensing aperture each of the portions having a span perpendicular to the length of the dispensing aperture.
8. (Rejected) The towel dispenser according to Claim 7, wherein said enlarged central portion has a span of at least about twice the span of the restricted terminal portions.
9. (Rejected) The towel dispenser according to Claim 8, wherein the terminal portions of the dispensing aperture have a span of from about 20 to about 40 percent of the width of said interfolded towels corresponding thereto.
10. (Rejected) The towel dispenser according to Claim 9, wherein said restricted terminal portions of said aperture have a span of about 30 percent of the width of said interfolded towels corresponding thereto and a collective length of at least about 40 percent of the abridged length L' of said dispensing aperture.
- 11-20. (Canceled)
21. (Rejected) In a gravity-feed towel dispenser for dispensing C-fold and interfolded towels, wherein said dispenser contains C-fold or interfolded towels having a transverse length, L, which are positioned to be dispensed through an elongated bottom dispensing aperture having a length of L or greater, said towel dispenser including means for defining a top portion, a front wall, a back wall and a pair of side walls of said towel dispenser, as well as a

bottom portion collectively defining an interior for receiving a stack of C-fold or interfolded towels, said bottom portion of said towel dispenser defining said elongated bottom dispensing aperture, said dispenser being of the class that are moved forwardly for reloading; the improvement comprising an adapter plate secured to said bottom portion of said towel dispenser configured to abridge the length of said dispensing aperture to a length L' of from about 80 percent to about 90 percent of said transverse length, L , of said C-fold or interfolded towels, wherein the adapter plate is pivotally secured to the dispenser to accommodate reloading.

22. (Rejected) The improvement according to Claim 21, wherein said adapter plate is pivotally secured to the sidewalls of the dispenser.

IX. EVIDENCE APPENDIX

Attached are a July, 2005 Examiner's *Affidavit* and three (3) photographs.

STATEMENT INDICATING ENTRY INTO RECORD

The July, 2005 *Affidavit* and the photographs were entered into the record on or about July 28, 2005 and were attached to the *Final Rejection* along with an additional *Affidavit* and photographs.

Examiner's Affidavit

in Support of the measured Bobrick Model 363 Towel

Dispenser Dimensions

I, Michael E. Butler, do hereby affirm the following facts based on measurements made on the Bobrick Model 363 Towel Dispensers located in the USPTO Crystal Park 5 restrooms.

The dispensing slot has a length of 10 ½ inches

The dispensing magazine has a towel major axis length of 11"

The dispensing slot has a width of 2 ½ inches in the middle

The dispensing slot has a width of ¾ inches at the end of the straight base

The arcuate surface bearing the dispensing slot has a chord of 10.5 cm

The arcuate surface bearing the dispensing slot has an arcuate length of 11.7 cm

The arcuate surface commences tangent to the horizontal back of the dispensing slot curving upward to a frontal non tangential termination relative the front panel with the following projections:

The arcuate surface has projection on the horizontal axis of 9.4 cm

The arcuate surface has a projection on the vertical axis of 6 cm

Attested to:

Michael E. Butler

July 25, 2005

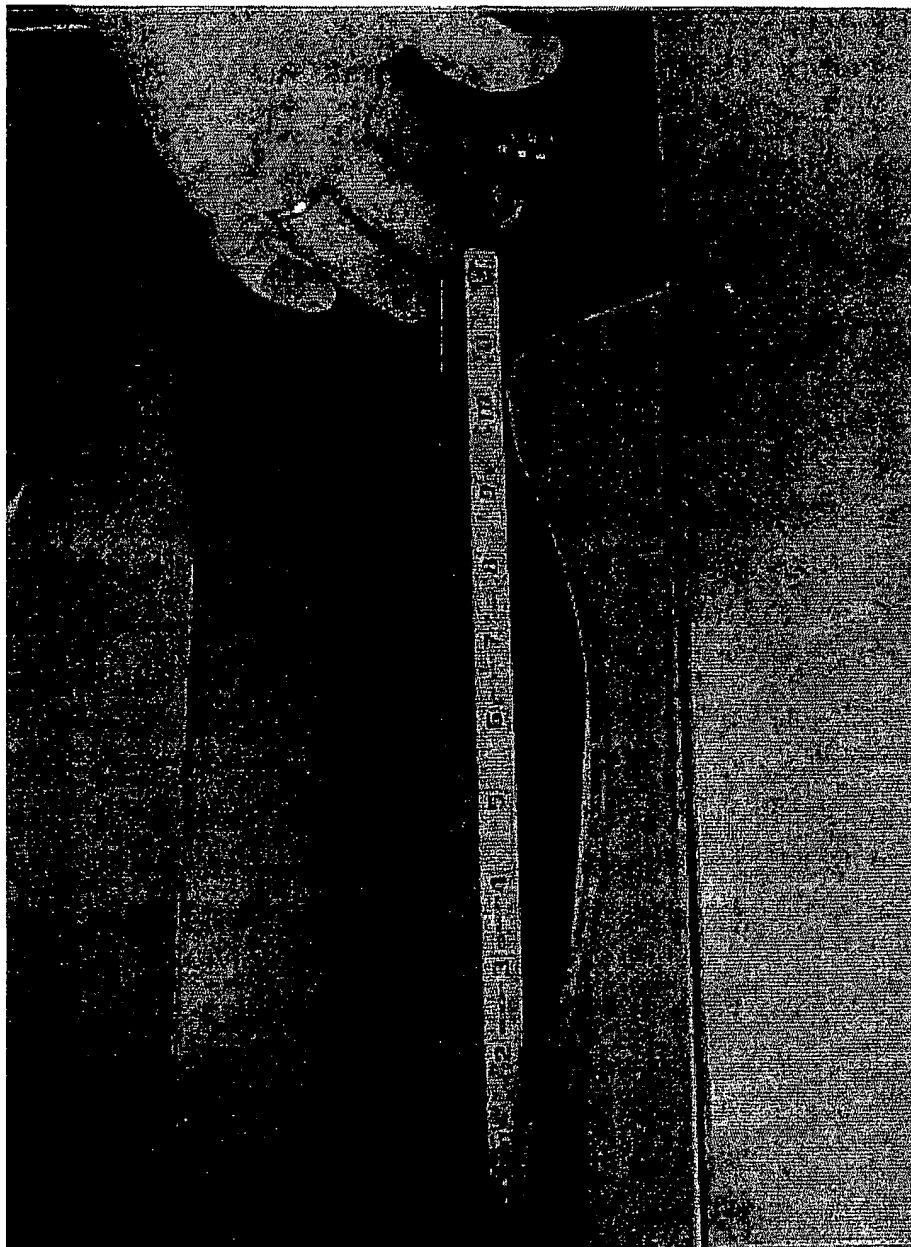
Michael E. Butler
Examiner
U.S. Patent & Trademark Office

Sworn and subscribed before me, in my presence,
this 25 day of July, 2005, a Virginia Notary
Public, in and for ~~Virginia~~ County/City,
Theresa Cresto
Notary Public

A5

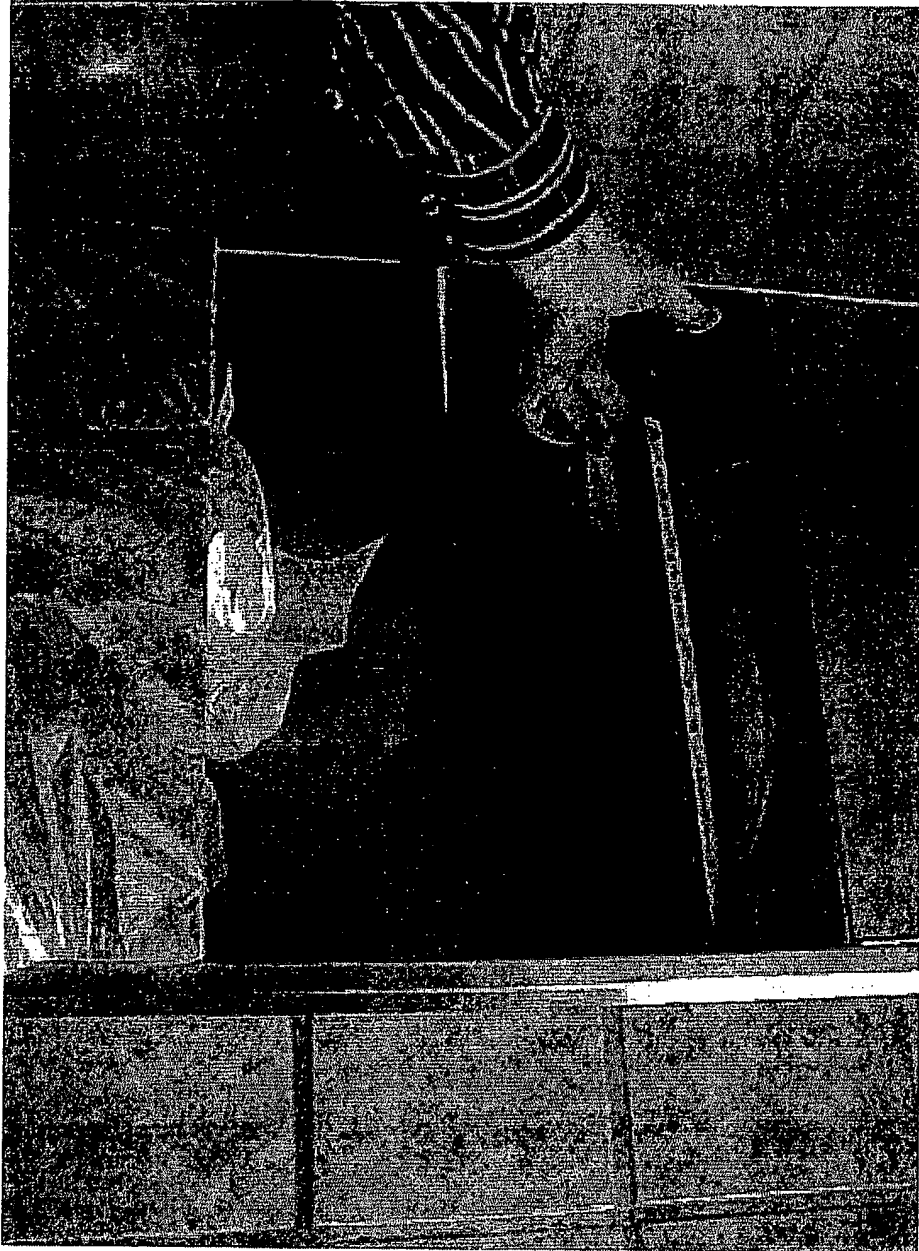
My Comm. Exps. *May 31 2009*

BEST AVAILABLE COPY



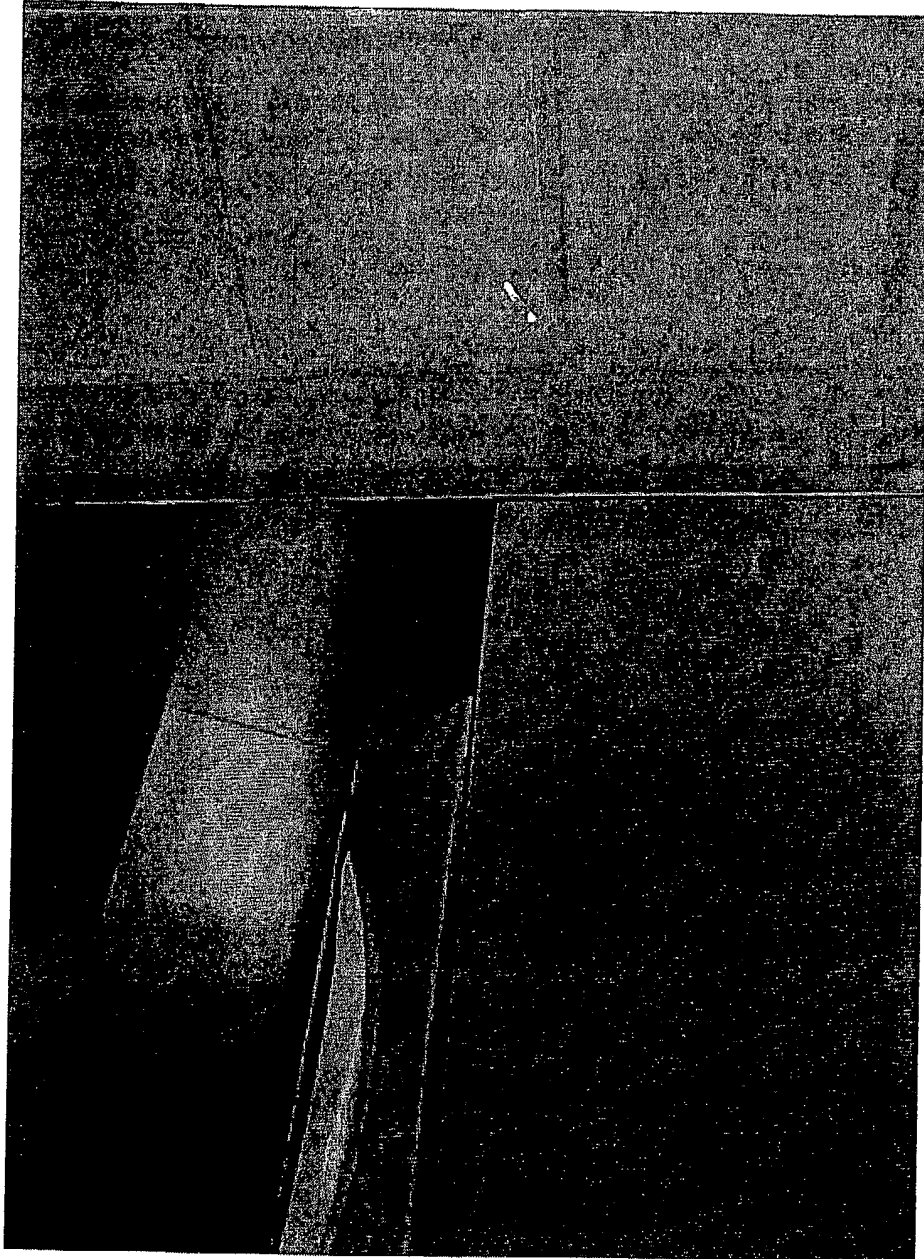
mvc-cp28

BEST AVAILABLE COPY



move-c11f

BEST AVAILABLE COPY



MVC-002f

X. RELATED PROCEEDINGS APPENDIX

There are no related appeals, interferences or judicial proceedings related to, or which will affect, or which will be affected by, or which will have a bearing on the Board's decision in this appeal.